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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------------------------------------------|-------------|------------------------|---------------------|------------------|
| 09/372,416 | 08/11/1999 | JONATHAN DORFMAN | EWG-087 | 1373 |
| 7590 BEH Investments LLC 1652 48th Street Brooklyn, NY 11204 | | | | |
| EXAMINER HUYNH, THU V | | | | |
| ART UNIT 2178 | | PAPER NUMBER | | |
| MAIL DATE 01/20/2011 | | DELIVERY MODE PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/372,416

Applicant(s)

DORFMAN, JONATHAN

Examiner

THU V. HUYNH

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-84 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SD-05)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: RCE filed on 10/28/2009 to application filed on 08/11/1999.
2. Claims 18-84 is pending in the case. Claims 19-84 are selected for examination.

Priority

3. This application includes a reference to Patent Application 08/787,979, now US Patent Number 6,285,987, filed on 01/22/1997. However, the inventor(s) of the instant application (DORFMAN, JONATHAN) is completely different the inventor(s) of the 08/787,979 (ROTH, DAVID W. AND SALISBURY, DYLAN). Since, the instant application does not have at least one common inventor in the application 08/787,979, the instant application cannot claim priority, such as a continuation in part of the application 08/787,979, even a reference of application 08/787,979 is incorporated in the original specification of the instant application.

Terminal Disclaimer

The terminal disclaimer filed on 4/28/2009 is considered disapproved on 5/7/2009, since 3.73(B) certificate is missing. The submission of 3.73(B) certificate filed on 10/28/2009 has not been considered by the specialist yet. Therefore, the double patenting is still remained in this office action. However, examiner will withdraw the double patenting rejection at the time the terminal disclaimer is considered and approved in next office action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 19-84 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 19-84 are not supported in the specification, except in the incorporated reference 08/787,979. However, as addressed in the Priority section, since the inventor(s) of the instant application is completely different from inventor(s) of the incorporated reference 08/787,979, the instant application cannot claim the subject matter of other inventor(s).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 19-84 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 09/216,206. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Regarding claims 19-51, claims 62-66, 69, 82, 97, 112-113 of the '206 teaches all limitation of claims 19-51, except the limitation of "serving by the computer system to the browser an advertisement associated with the selected bid". However, claim 62 of the '206 teaches "identify in the computer system an advertisement associated with the selected bid" and "an opportunity to server and advertisement to a browser". It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have included serving the identified advertisement, since that is the purpose of the claim 62 of the '206.

Regarding claims 52-84, claims 114-118, 121, 134, 149, 164-165 of the '206 teaches all limitation of claims 19-51, except the limitation of "serving by the computer system to the browser an advertisement associated with the selected bid". However, claim 62 of the '206 teaches "identify in the computer system an advertisement associated with the selected bid" and "an opportunity to server and advertisement to a browser". It would have been obvious to a person of ordinary skill in the art at the time

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the invention was made to have included serving the identified advertisement, since that is the purpose of the claim 62 of the '206.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 19-84 are rejected under 35 U.S.C. 102(b) as being anticipated by Ronald R. Yager, “Intelligent Agents for World Wide Web Advertising Decisions”, International Journal of Intelligent Systems, Vol. 12, pp. 379-390, 1997.**

Regarding independent claim 19, Yager discloses a method implemented in a computer system comprising of one or more networked computers, for determining in response to an advertising opportunity, which advertisement of a plurality of advertisements to provide for fulfilling the advertising opportunity, the advertising opportunity being an opportunity to serve an advertisement to a browser in response to a request for content by the browser, the method comprising:

- maintaining in the computer system a plurality of sets of bidding parameters, each set of bidding parameters being associated with one or more of the

plurality of advertisements and an advertiser, whereby the each set of bidding parameters indicates whether the associated advertiser is desirous that a bid should be submitted for providing one of the associated one or more of the plurality of advertisements for fulfilling the each advertising opportunity. (Page 384, Paragraph 1);

- receiving in the computer system an indication of the request for content, thereby presenting the each advertising opportunity. (Page 383, Paragraph 2);
- in response to the request for content: submitting in the computer system one or more bids, each submitted bid being based on one of the sets of bidding parameters, the one of the sets of bidding parameters being met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance with the one of the sets of bidding parameters, is associated with a monetary amount that an advertiser associated with the each submitted bid is willing to pay if the each submitted bid is selected and a specific event occurs. (Page 383, Paragraph 2 through Paragraph 3);
- selecting in the computer system a bid from among the submitted bids. (Page 384, Paragraph 1); and
- serving by the computer system to the browser an advertisement associated with the selected bid, whereby the identified advertisement is determined by a bidding process. (Page 384, Paragraph 1).

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Regarding claim 20, Yager teaches the monetary amount associated with each of the submitted bids is included in the each of the submitted bids (Page 383, Paragraph 2 through Paragraph 3)

Regarding claim 21, Yager teaches the specific event for which the advertiser associated with each of the determined bids is willing to pay the monetary amount associated with the each of the submitted bids, is a same respective event for all of the submitted and determined bids. (Page 383, Paragraph 2 through Paragraph 3).

Regarding claim 22, Yager teaches the specific event for which the advertiser associated with at least one of the submitted bids is willing to pay the monetary amount associated with the at least one of the submitted bids, is a serving of an advertisement associated with the at least one of the submitted bids to the browser in fulfillment of the each advertising opportunity. (Page 383, Paragraph 3).

Regarding claim 23, Yager teaches the specific event for which the advertiser associated with at least one determined bid is willing to pay the monetary amount associated with the at least one submitted and determined bid is a serving of an advertisement associated with the at least one submitted and determined bid to the browser in fulfillment of the each advertising opportunity. (Page 383, Paragraph 3).

Regarding claims 24-28, Yager teaches the request for content by the browser is caused by a reference in the web page (Page 384, Paragraph 1).

Regarding claim 29, Yager teaches each submitted bid is associated with a respective bidding agent (Page 383, Paragraph 2 through Paragraph 3; and Page 384, Paragraph 1).

Regarding claim 30, Yager teaches each submitted bid includes a reference to an advertisement associated with the each submitted bid. (Page 383, Paragraph 2 through Paragraph 3; and Page 384, Paragraph 1).

Regarding claim 31, Yager teaches information about a viewer utilizing the browser is maintained in the computer system (Page 382, Paragraph 6).

Regarding claim 32, Yager teaches the selection of the selected bid is based on the selected bid being determined in the computer system as having a highest beneficial value over respective beneficial values of other submitted bids (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3).

Regarding claim 33, Yager teaches the monetary amount associated with each of the submitted bids is included in the each of the submitted bids (Page 383, Paragraph 2 through Paragraph 3).

Regarding claim 34, Yager teaches the specific event for which the advertiser associated with each of the submitted bids is willing to pay the monetary amount

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associated with the each of the submitted bids, is a same respective event for all of the submitted bids (Page 383, Paragraph 2 through Paragraph 3).

Regarding claim 35, Yager teaches the specific event for which the advertiser associated with at least one of the submitted bids is willing to pay the monetary amount associated with the at least one of the submitted bids, is a serving of an advertisement associated with the at least one of the submitted bids to the browser in fulfillment of the advertising opportunity (Page 383, Paragraph 3).

Regarding claim 36, Yager teaches the specific event for which the advertiser associated with each of the submitted bids is willing to pay the monetary amount associated with the each of the submitted bids, is a serving of an advertisement associated with the each of the submitted bids to the browser in fulfillment of the advertising opportunity (Page 383, Paragraph 3).

Regarding claims 37-41, which are dependent on claims 32-36, Yager teaches the request for content by the browser is caused by a reference in a web page (Page 384, Paragraph 1).

Regarding claim 42, Yager teaches the selection of the selected bid is based on the selected bid being associated with a highest monetary amount (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3).

Regarding claim 43, Yager teaches the monetary amount associated with each of the submitted bids is included in the each of the submitted bids (Page 383, Paragraph 2 through Paragraph 3).

Regarding claim 44, Yager teaches the specific event for which the advertiser associated with each of the submitted bids is willing to pay the monetary amount associated with the each of the submitted bids, is a same respective event for all of the submitted bids (Page 383, Paragraph 2 through Paragraph 3).

Regarding claim 45, Yager teaches the specific event for which the advertiser associated with at least one of the submitted bids is willing to pay the monetary amount associated with the at least one of the submitted bids, is a serving of an advertisement associated with the at least one of the submitted bids to the browser in fulfillment of the advertising opportunity (Page 383, Paragraph 3).

Regarding claim 45, Yager teaches the specific event for which the advertiser associated with each of the submitted bids is willing to pay the monetary amount associated with the each of the submitted bids, is a serving of an advertisement associated with the each of the submitted bids to the browser in fulfillment of the advertising opportunity (Page 383, Paragraph 3).

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Regarding claims 45-51, which are dependent on claims 42-46, Yager teaches the request for content by the browser is caused by a reference in a web page (Page 384, Paragraph 1).

Claims 52-84 are for computer system performing the methods of claims 19-51 respectively and are rejected under the same rationale.

Response to Arguments

Applicant(s) request to withdraw the rejection over Yager.

However, the rejections over Yager is still remained, since the inventorship issue is not resolved.

Applicant(s) request suspend further action in the present application until a petition to correct the inventor ship is granted by the Office of Petitions.

Since examiner must process the application in a time frame when the application is amended and forwarded to examiner for processing, therefore, examiner can not suspend further action in the present application until the inventor/applicant is found to sign the statement and declaration in order to submit a petition to correct the inventor ship is granted by the Office of Petitions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V. Huynh whose telephone number is (571) 272-4126. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thu Huynh/
Primary Examiner, Art Unit 2178
January 18, 2011

